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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/080,672	02/25/2002	Katsutoshi Misuda	03500.016227	8154
5514	7590	07/07/2006	EXAMINER	
FITZPATRICK CELLA HARPER & SCINTO 30 ROCKEFELLER PLAZA NEW YORK, NY 10112			FERGUSON, LAWRENCE D	
			ART UNIT	PAPER NUMBER
			1774	

DATE MAILED: 07/07/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 10/080,672	<b>Applicant(s)</b> MISUDA, KATSUTOSHI	
	<b>Examiner</b> Lawrence D. Ferguson	<b>Art Unit</b> 1774	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 10 April 2006.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1,3-7 and 9-14 is/are pending in the application.
- 4a) Of the above claim(s) 13 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,3-4, 6, 9-12 and 14 is/are rejected.
- 7) ☒ Claim(s) 5 and 7 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

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## **DETAILED ACTION**

### ***Response to Amendment***

1. This action is in response to the amendment held April 10, 2006.

Claims 1 and 3 are amended and claim 14 is added rendering claims 1, 3-7 and 9-14 pending, with claim 13 withdrawn as a non-elected invention.

### ***Claim Rejections – 35 USC § 103(a)***

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1, 3-4, 6, 9-12 and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hirose et al. (U.S. 6,203,899) in view of Barcock et al (U.S. 6,502,935).

Hirose discloses an ink jet recording medium comprising a base material, ink receiving layer provided on the base material and a surface layer (dye fixing layer) provided on the ink receiving layer (column 2, lines 40-60) where the particles making up the surface layer fixes the coloring material component to the surface layer (column 3, lines 40-45 and column 4, lines 60-65). The ink-receiving layer is equivalent to the

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claimed light-reflecting layer because it contains light reflecting material, such as aluminum. The reference discloses the ink receiving layer includes pigments such as silica and alumina which are used singly or in combination, where it is preferable to use at least one selected from silica and alumina (column 5, lines 50-67). The surface layer of Hirose includes alumina hydrate (column 3, line 52 through column 4, line 12) where the particles are within a range of from 0 to 100 parts by weight (column 5, lines 34-40) and the surface layer has a 20 glossiness of 20% or higher (column 5, lines 45-49).

Instant claim 12, the phrase, "an image forming method, comprising a step of conducting recording on the recording medium...by an ink-jet recording system" introduces a process limitation to the product claim. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process." In re Thorpe, 777 F.2d 695, 698, 227 USPQ 964, 966. Further, process limitations are given no patentable weight in product claims. Hirose does not disclose wherein the average particle size of the aluminum pigment is smaller than the average particle size of the silica pigment or barium sulfate.

Barcock discloses an ink jet recording material (column 1, lines 9-10) comprising a support material and pigment layers provided on the support material, which comprise a lower layer (light reflecting layer) containing barium sulfate having a particle size of 0.2 to 2.0 $\mu$ m (pigment A) and an upper layer (dye-fixing layer) containing aluminum oxide having a particle size of 0.7 to 5 $\mu$ m, where the lower layer may also contain

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aluminum and silicic material, having a particle size of 0.7 to  $5\mu\text{m}$  (pigment B) (column 2, lines 1-29, 62-65 and column 6, lines 40-49). The light reflecting layer is equivalent to the lower layer because the underlayer comprises light reflecting material, such as aluminum. Barcock further discloses the upper layer comprises dye-fixing agents (column 3, lines 24-25) and the recording material is glossy (column 1, lines 63-67). Hirose and Barcock are analogous art because they are both directed to ink jet-recording material. It would have been obvious to one of ordinary skill in the art to include barium sulfate in the ink-receiving layer of Hirose to improve the adhesion to the support (column 2, lines 39-42). Neither reference teaches a refractive index of the recording medium, as in instant claim 6, this feature is directly related to the specific pigmented particles used. Since the references use the same barium sulfate in the underlayer and the same dye-fixing layer, respectively, the refractive index of the recording material would be expected to be the same as Applicant claims. Neither reference discloses the claimed glossiness value; however, such gloss values are properties which can be easily determined by one of ordinary skill in the art. With regard to the limitation of the glossiness value, absent a showing of unexpected results, it is obvious to modify the conditions of a composition because they are merely the result of routine experimentation. The experimental modification of prior art in order to optimize operation conditions (e.g. glossiness value) fails to render claims patentable in the absence of unexpected results. The glossiness value of the dye-fixing layer are optimizable as they directly affect the opacity of the light-reflecting layer. It would have been obvious to one of ordinary skill in the art to make the light reflecting layer with the

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limitations of the glossiness value of the dye fixing layer since it has been held that discovering an optimum value of a result effective variable involves only routine skill in the art. (*In re Boesch*, 617 USPQ 215 (CCPA 1980) and *Slaney*, 205 USPQ 215).

4. Claims 5 and 7 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. The closest prior art does not teach or suggest the recited recording medium further including wherein the pigment (A) is an aluminum pigment or wherein pigment (B) is barium sulfate. The prior art does not teach motivation or suggestion for modification to make the invention as instantly claimed.

### ***Response to Arguments***

5. Arguments regarding rejection made under 35 U.S.C. 103(a) as being unpatentable over Hirose et al. (U.S. 6,203,899) in view of Barcock et al (U.S. 6,502,935). Applicant argues in Barcock, the particle size of pigment A is opposite to the relationship cited in the amended claims of having a particle size of not larger than 0.5um. Claims 5 and 7 have been withdrawn from the rejection; however, the rejection over the remaining claims have been maintained because Barcock discloses an ink jet recording material (column 1, lines 9-10) comprising a lower layer (light reflecting layer) containing barium sulfate having a particle size of 0.2 to 2.0 $\mu$ m (pigment A) and an upper layer (dye-fixing layer) containing aluminum oxide having a particle size of 0.7 to

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5 $\mu$ m, where the lower layer may also contain aluminum and silicic material, having a particle size of 0.7 to 5 $\mu$ m (pigment B) (column 2, lines 1-29, 62-65 and column 6, lines 40-49). The light reflecting layer is equivalent to the lower layer because the underlayer comprises light reflecting material, such as aluminum. Regarding claim 10, Applicant does not specify which pigment is A or B and the particle size of aluminum pigment (0.7 to 5 $\mu$ m) is smaller than the particle size of the barium sulfate (0.2 to 2.0 $\mu$ m).

6. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

### **Conclusion**

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lawrence Ferguson whose telephone number is 571-


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272-1522. The examiner can normally be reached on Monday through Friday 9:00 AM – 5:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rena Dye, can be reached on 571-272-3186. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
L. Ferguson  
Patent Examiner  
AU 1774

  
RENA DYE  
SUPERVISORY PATENT EXAMINER  
A.U. 1774 6/23/07